UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte TOSHIKI KINDO, HIDEYUKI YOSHIDA,
and TAKEHIKO SHIDA

———————————————

Appeal 2007-3780
Application 09/989,151[1]
Technology Center 2100

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Decided: May 13, 2008

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Before ALLEN R. MACDONALD, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

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[1] Application filed November 21, 2001. Appellants claim the benefit under
35 U.S.C. § 119 of Japan patent application JP2000-359,044, filed
11/27/2000. The real party in interest is Matusshita Electric Industrial Co.
Ltd.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal from a final rejection of claims 20 and 23 to 28 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to an information distribution system and method in which two content providers are managed so as to present user information to a client filtered for his needs. The information from one of the providers (e.g. news articles) is carefully scored and weighed against a user profile of the user's preferences, and undergoes a learning process; the information from the other source (e.g., ads, perhaps related to the news subjects) does not undergo a learning process of its own. In the words of the Appellants:

> In an information distribution system that rates distribution information pieces from a distribution information provider based on a personal profile to distribute to a client where the personal profile has registered therewith various keywords contained in the distribution information pieces provided from the distribution information provider and evaluation values corresponding to the keywords and the evaluation values are learned in advance based on preferences of the client, distribution information pieces from another distribution information provider different from the distribution information provider are rated based on the personal profile to distribute to the client.

(Spec., 49.)

Claim 20 is exemplary:

20. An information distribution system, comprising:

a profile storer that stores a personal profile that includes at least one evaluation value of a keyword contained in distribution information provided from a first information distribution provider, wherein the at least one evaluation value is calculated based upon a user's past selection of distribution information containing the keyword; and

an information distributor that rates the distribution information provide from the first information distribution provider with the keyword based on the personal profile and sends the distribution information to a client, wherein said information distributor rates distribution information provided from a second information distribution provider with a keyword based on the personal profile and sends the distribution information to the client, said information distributor comprising:

a first information filter that rates the distribution information from the first information distribution provider based on the at least one evaluation value included in the personal profile in correspondence to the keyword contained in the distribution information, sends the distribution information to the client, and performs a learning process that changes the at least one evaluation value of the keyword contained in the distribution information from said first information distribution provider in the personal profile, based on the distribution information and preference information of the client about the distribution information; and

a second information filter that rates the distribution information from the second information distribution provider based on the at least one evaluation value included in the personal profile in correspondence to the keyword contained in the distribution information, and sends the distribution information to the client, wherein said second information filter does not perform the learning process based on the distribution information from the second information distribution provider.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Driscoll	US 5,717,913	Feb. 10, 1998
Klein	US 5,872,850	Feb. 16, 1999
Ariyoshi	US 6,408,288 B1	Jun. 18, 2002
		(filed Feb. 24, 1998)

Rejections:

R1: Claims 20, 23, and 24 stand rejected under 35 U.S.C. § 103(a) for being obvious over Klein in view of Ariyoshi and further in view of Driscoll.

R2: Claims 25 to 28 stand rejected under 35 U.S.C. § 103(a) for being obvious over Klein in view of Ariyoshi.

Appellants contend that the claimed subject matter is not rendered obvious by Klein in combination with Ariyoshi or Ariyoshi and Driscoll, for failure of the references to teach important claimed limitations. The Examiner contends that each of the claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Brief and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this opinion. Arguments which Appellants could have made but chose not to

make in the Brief has not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).[2]

We affirm-in-part.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue turns on whether the references teach the claimed limitations, specifically the limitation concerning whether a second information filter is performing a learning process.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented an information distribution system that ranks information and presents it to a client user. The information is from two (or more) content providers. (Figs. 2, 10; pages 6, top and 35, top). A typical use of this system and method is to score and rank newspaper

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[2] Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group, except as will be noted in this opinion. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

information pieces from a content provider (page 14, middle) customizing the content for a user with a user profile stored in the system. The information is updated by a learning process which customizes the information to the needs of the client user. (Page 16, bottom, and continuing). Along with the first information is provided to the user a second type of information, typically advertising. (Page 8, l. 11+). The advertising is selected based on the same keywords as learned for the client user. (Page 23, l. 16+). However, the advertising keyword ranking is not separately learned, but rather relies on the processing that is done for the related news information. (Page 27, l. 7+).

2. Klein teaches a system for efficiently filtering content for a user viewing information, goods or services over the Internet. (Col. 1, l. 27). The system stores one or more user profiles for each of a plurality of users, with ratings updated either by explicit or inferred actions of the user. (Col. 5, ll. 1-25). By reviewing the ratings of items by a plurality of users, a generalized rating value for the item can be calculated. (Col. 5, l. 50). The validity of various ratings can be cross checked among users, resulting in confidence factors for the ratings. (Col. 6, l. 7).

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a

rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

References within the statutory terms of 35 U.S.C. § 103 qualify as prior art for an obviousness determination only when analogous to the claimed invention. *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992). Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986); see also *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979) and *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). Furthermore, "'there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness' . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

From our review of the administrative record, we find that the Examiner has presented a prima facie case for the R1 and R2 rejections of Appellants' claims under 35 U.S.C. § 103. The prima facie case is presented on pages 3 to 8 of the Examiner's Answer.

In opposition, Appellants present a number of arguments. The first argument, relevant to claims 20, 23, and 24, contends that

> "Klein fails to disclose or suggest a filter which rates distribution information based on evaluation values included in a stored profile, but does **not** perform a learning process that changes the evaluation values based on the distribution information and preference information of a client about the distribution information, as recited in Appellants' claim 20" [emphasis added] (App. Br., 10, bottom).

The Examiner first asserts that "Klein and Ariyoshi combination does not disclose the second filter that does not perform the learning process. Driscoll discloses an information filtering system for retrieving relevant text data from a database ([cites]). Driscoll clearly discloses the filtering of text data in the database not based on the learning process". (Answer 5, top). Thus, in restating the rejection the Examiner is relying on Driscoll to teach a first information filter that "performs a learning process that changes the at least one evaluation value of the keyword ..." and a second information filter that "does not perform the learning process..." as required by Claim 20. However, as shown in Figure 1, the information filter in Driscoll does contain a modification loop #26 that performs the learning process. The

Examiner has not presented evidence in Driscoll for the differentiated learning process.

Later in the Examiner's Answer, the Examiner points to Klein as being the reference which teaches the two filters, one of which learns and one of which does not learn. (Answer 9, top). While we agree that Klein teaches a system with a multiple number of users, and multiple filters for the various data stores for each of the users (see FF #2 above), we fail to find in any of the Klein citations proffered by the Examiner the two filters, one of which performs a learning process and one of which does not perform the learning process.

We thus agree with the Appellants that the Examiner has erred in rejecting claims 20, 23, and 24 over the cited art. As claim 28 contains a limitation similar in scope to that of the three other claims just listed, we find error in the rejection of that claim as well.

Appellants argue against the rejection R2 of claims 25, 26, and 27 "that Kein's system merely rates items (such as sound recordings, movies, restaurants, vacation destinations, novels, or World Wide Web pages), but does not send these items to a client, as recited in Appellants' claims 25 and 26". (App. Br. 17). Appellants' claims clearly recite that the distribution information is sent to the client, not necessarily the items themselves. In Klein, column 1, lines 20 to 46, it is clearly stated that the prior art teaches sending rated information to the users. Various filtering methods are then described.

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Appellants also argue that the Klein and Ariyoshi references cannot be properly combined, as there is no motivation for one to use the two teachings. As both Klein and Ariyoshi are addressed to the same field of endeavor (filtering information over the Internet) we find that the combination is proper. (See *In re Clay* cited above.)

We do not find error with the Examiner's rejection of claims 25, 26, and 27.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner erred in rejecting claims 20, 23, 24, and 28. We do not find error in the rejection of claims 25 to 27.

DECISION

The Examiner's rejection of claims 20, 23, 24, and 28 is reversed. The rejection of claims 25 to 27 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

<u>AFFIRMED-IN-PART</u>

rwk

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